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OFFICE OF PETITIONS

In re Application of	:	
Reifsnyder et al.	:	ON REQUEST FOR
Application No. 10/753078	:	RECONSIDERATION OF
Filing or 371(c) Date: 01/08/2004	:	PATENT TERM ADJUSTMENT
Attorney Docket Number:	:	
12441.00050/16331.004	:	

This is a decision on the “REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b),” filed June 14, 2010. Applicants petition for reconsideration of the patent term adjustment calculation to 360 days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction based upon (1) an assertion that the Office erred in calculating a delay of 94 days, and (2) on the basis that the Office will take in excess of three years to issue this patent.

The Request for Reconsideration of Patent Term Adjustment (“PTA”) under 37 CFR 1.705(b), as it relates to the assertion that the Office erred in failing to calculate a delay of 94 days is **DISMISSED**.

The Request for Reconsideration of Patent Term Adjustment (“PTA”) under 37 CFR 1.705(b), as it relates to the Office’s failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

On March 12, 2010, this Office mailed a Notice of Allowance and Issue Fee Due, including a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 0 days.

On June 14, 2010, Applicants timely submitted the instant application for patent term adjustment¹. Applicants request that the Determination of Patent Term Adjustment be corrected from 0 days, as indicated on the Determination of PTA mailed March 12, 2010, to an adjustment of 360 days. Applicants assert that the Office erred in calculation a reduction of 94 days pursuant to 37 CFR 1.704(c)(8), in connection with the filing of a Supplemental Information Disclosure

¹ PALM records show that the Issue Fee payment was received in the Office on June 14, 2010.

Statement (“IDS”) on February 16, 2006, after filing a reply to a Election/Restriction Requirement on November 14, 2005.

Applicants also request an adjustment of 349 days on the basis that the Office will take in excess of three years to issue this patent.

As to the assertion that the Office erred in calculating a delay of 94 days, Office records reveal that Applicants filed the response to the Election/Restriction Requirement on November 14, 2005. Thereafter, Applicants filed a Supplemental IDS on February 16, 2006. Pursuant to 37 CFR 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. It is undisputed that after filing a response on November 14, 2005, applicants filed an IDS on February 16, 2006. The record does not support a conclusion that the IDS was expressly requested by the examiner. Further, a review of the IDS filed December 4, 2008, reveals that it did not include the proper § 1.704(d) statement². Accordingly, it is concluded that the period of reduction of 94 days is correct and will not be changed.

A review of Office records also reveals that the Office errantly neglected to assess a reduction in connection with the reply to the Notice to File Missing parts of Nonprovisional Application (“Notice”), mailed March 23, 2004. The Notice required, *inter alia*, a properly signed oath or declaration. Applicants filed a partial response to the Notice entitled SUBMISSION OF SUBSTITUTE SEQUENCE LISTING, on April 14, 2004, which did not include a properly signed oath or declaration. Applicants thereafter filed a response to the Notice, including an oath/declaration, on May 24, 2004. Pursuant to 37 CFR 1.704(c)(7), a reduction of forty (40) days, beginning on the day after the date the reply having an omission was filed, April 15, 2004, and ending on the date that the reply or other paper correcting the omission was filed, May 24, 2004, is appropriate.

As to the Office’s failure to issue the patent within 3 years of the filing date, knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

² 37 CFR 1.704(d) provides that a paper containing only an information disclosure statement in compliance with 37 CFR 1.97 and 1.98 will not be considered (result in a reduction) under 37 CFR 1.704(c)(6), 1.704(c)(8), 1.704(c)(9), or 1.704(c)(10) if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 CFR 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee³.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent, including any request as it relates to the Office's failure to issue the patent within 3 years of the filing date, must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

³ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

A handwritten signature in black ink, appearing to read 'Anthony Knight', is positioned above the printed name.

Anthony Knight
Director
Office of Petitions

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